

REMARKS

Claims 9-11, 13, 14 and 16-20 are pending in the application.

Claims 9-11, 13, 14 and 16-20 have been rejected.

Claims 9, 14, and 17 have been amended.

Rejection of Claims Under 35 U.S.C. §103

Claims 9-11, 13, 14 and 16-20 and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Microsoft PowerPoint 2000, “Selling an Idea for a Product,” March 10, 1999, pages 1-19 (“MPP2000”) in view of U.S. Patent No. 6,938,032 issued to Heath et al. (“Heath”) in further view of U.S. Patent No. 6,490,601 issued to Markus et al. (“Markus”). Applicants respectfully traverse this rejection.

In order for a claim to be rendered invalid under 35 U.S.C. §103, the subject matter of the claim as a whole would have to be obvious to a person of ordinary skill in the art at the time the invention was made. *See* 35 U.S.C. §103(a). This requires: (1) the reference(s) must teach or suggest all of the claim limitations; (2) there must be some teaching, suggestion or motivation to combine references either in the references themselves or in the knowledge of the art; and (3) there must be a reasonable expectation of success. *See* MPEP 2143; MPEP 2143.03; *In re Rouffet*, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Independent Claims 9, 14 and 17 have been amended to clarify that the limitation of “determining whether to include each of the plurality of component definitions in the slide presentation based on its associated query condition” (*see, e.g.*, Claim 1) is performed by the computer (or processor) on which the method is performed or that is part of a claimed system. In addition, the independent claims have been amended to clarify that the determining step is

performed without human interaction. Applicants respectfully submit that neither MPP2000 nor Heath contain disclosure of these amended limitations.

The Office Action admits that MPP2000 “does not specifically teach a means... for determining whether to include each of a plurality of component definitions in the slide presentations based on the query condition” (*see* Office Action, p.3), a proposition with which Applicants agree. The Office Action relies upon disclosure within Heath for purportedly supplying this claim limitation, along with others related to the “query condition” claim element. Applicants respectfully submit that none of the cited sections of Heath provides disclosure of the claimed determining being performed by a computer without human interaction, as now claimed. Heath provides disclosure related to purportedly searching a predetermined topic list or a key word in order to retrieve slides conforming to the search. *See* Heath 4:3-8; 4:18-21. The user then performs a selection process of the found slides that they wish to include in a presentation. *See* Heath 4:18-30. Applicants respectfully submit that throughout this disclosed process, the user provides the search criteria and manually performs the selection of the slides desired to be included in a slide presentation. Thus, the cited sections of Heath provide no disclosure of the computer performing the selection process without human interaction.

In addition, the independent claims have been amended such that the determining step is performed using opportunity-specific data. The cited sections of Heath provide no disclosure of using opportunity-specific data to determine which slides are included in a slide presentation. In fact, the cited sections of Heath provide no disclosure of opportunity-specific data at all and, therefore, cannot be said to use such data in the performance of such a determining step, as claimed.

For the reasons presented above, neither MPP2000 nor Heath, alone or in combination teach these limitations of independent Claims 9, 14 and 17. Further, Applicants submit that the Office Action provides no indication that Markus provides this missing disclosure, alone or in combination with the other references. The burden is on the Examiner to support a case of obviousness, including whether the prior art references teach or suggest all of the claimed limitations. *See* MPEP 706.02(j).

Applicants also submit that the Office Action does not satisfy the burden of factually supporting a motivation to combine the references. The Examiner's duty may not be satisfied by engaging in impermissible hindsight; any conclusion of obviousness must be reached on the basis of facts gleaned from the references. The Examiner must therefore provide evidence to suggest the combination and "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *See In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Further, the Office Action does not establish that such a combination of the teachings of these references would meet with success, as required.

Applicants respectfully submit that there is no suggestion to combine MPP2000 with the teachings of Markus. MPP2000 appears to be a printout of a presentation purportedly included with Microsoft PowerPoint 2000, purportedly published on or about 1999. The presentation appears to be a collection of slides that include bullet-pointed text and some graphics. MPP2000 is introduced by the Office Action as purportedly providing disclosure of the claim limitation: "presentation definition template having a plurality of component definitions, at least one component definition having an information bookmark," a proposition with which Applicants do not necessarily agree. The Office Action admits that MPP2000 "does not teach mapping the information bookmark and the opportunity-specific data and automatically replacing the bookmark with the mapped data when creating the slide presentation." Office Action, p.4 (a

proposition with which Applicants do agree). The Office Action then introduces Markus as purportedly providing such disclosure, and then cites to the summary of Markus as support for such a proposition. The Office Action suggests that a person of ordinary skill might be motivated to perform such a combination because “Markus et al. taught that doing so would quickly and automatically fill out electronic presentations, relieving the user of the burden of manually inputting the data.” Office Action, p.4. Applicants respectfully submit, however, that the system disclosed by Markus is non-analogous to the disclosure of MPP2000 and therefore a person of ordinary skill in the art would not be motivated to provide such a combination.

Markus discloses a mechanism for purportedly including user-specific information in a web-page form displayed on a client browser. Markus discloses using a remote server (“privacy bank”) to store the user-specific information. The remote server also has registered sites, which provide the site-specific information needed for web-based forms generated by the registered site. The remote server/privacy bank then sends a Java Script profile to a client browser to fill in a web-based form, after a user identification is transmitted to the privacy bank. The client browser then runs the Java Script to fill in blanks in the web form. *See Markus 7:63-8:39.* Markus further discloses the privacy bank storing the user-specific information in association with a set of “standard field descriptors.” There is then a mapping associated with the registered sites relating the standard field descriptors to a set of “non-standard field descriptors” found in the registered site’s web-based form. *See Markus 9:2-12.* Markus then discloses purportedly including the standard field descriptor data in the Java Script in association with the non-standard field descriptors of the web-based form. The Java Script is sent to the client browser, which then purportedly inserts that information into the electronic form. Markus purports to provide this functionality as an aid to helping users to avoid the tedious task of filling in electronic forms with the same type of data.

Applicants respectfully submit that there is no suggestion to combine the web-based mechanism disclosed by Markus with the presentation slides provided by MPP2000. MPP2000 purports to provide a PowerPoint slide presentation, not a client browser display of a web page. There is no indication that the program associated with MPP2000 is capable of processing a Java Script routine, as provided by Markus. In addition, there is no indication from MPP2000 that there are identifiers for any of the purported information bookmarks that could be identified and used to determine the appropriate “standard field descriptor” of Markus. Applicants therefore respectfully submit that for these reasons a person of ordinary skill in the art would not be motivated to combine MPP2000 with Markus.

Applicants respectfully submit that the arguments presented in the Office Action failed to establish a *prima facie* case of obviousness and run perilously close to a forbidden hindsight analysis of the references. The Office Action makes no showing of a motivation to combine MPP2000 with Markus from within the references themselves; therefore, it must be presumed that there is none. It is well-established that the best defense to hindsight is a “rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references.” See *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1371 (Fed. Cir. 2000); *Brown & Williamson Tobacco Corp. v. Philip Morris, Inc.*, 229, F.3d 1120, 1124-25 (Fed. Cir. 2000). A showing of combinability must be “clear and particular” and “broad conclusive statements about the teaching of multiple references, standing alone, are not ‘evidence.’” See *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 666 (Fed. Cir. 2000); *Brown & Williamson*, 229 F.3d at 1125.

The reason, suggestion, or motivation to combine may be found explicitly or implicitly: 1) in the prior art references themselves; 2) in the knowledge of those of ordinary skill in the art that certain references, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature

of the problem to be solved, “leading inventors to look to references relating to possible solutions to that problem.”

Ruiz, 234 F.3d at 665.

The Office Action presents nothing more than broad, generalized statements related to the motivation of a person of ordinary skill, which Applicants respectfully submit is insufficient to support a finding of obviousness. The Office Action does not establish that the references which are combined are of special interest or importance in the field. Indeed, Markus is in the separate and distinct field of filling out fields in an electronic form document on a browser program using a remote server, rather than the field of Microsoft PowerPoint in MPP2000. Nor does the Office Action present any evidence of a problem to be solved from within those references themselves.¹ Instead, the Office Action fabricates such a problem to be solved, not from the teachings of the cited references, but from the teaching of Applicant’s own disclosure.

Using Applicant’s own disclosure as a blueprint for providing a motivation to combine prior art references in an obviousness determination is impermissible. *See W. L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552-53 (Fed. Cir. 1983) (“to imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher”).

In addition, the Office Action fails to establish that a combination of the teachings of MPP2000 with the teachings of Markus would meet with success, as required. For the reasons discussed above, there is no reason to believe that the web-browser / Java Script-based teachings of Markus could be successfully incorporated in the PowerPoint environment of MPP2000. As

¹ There must be a finding that “there was a disadvantage to the prior systems, such that the “nature of the problem” will have motivated a person of ordinary skill to combine the prior art references.” *Id.* At 666.

noted above, MPP2000 provides no equivalent to the "non-standard field descriptors" of Markus, and therefore, Markus' disclosed mapping between non-standard and standard field descriptors could not be performed. Similarly, there is no indication that the purported Java Script functionality of Markus could function in the PowerPoint environment of MPP2000. Therefore, Applicants respectfully submit that a combination of Markus with MPP2000 would not meet with success.

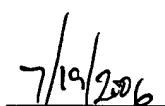
For these reasons, Applicants respectfully submit that the Office Action fails to present a *prima facie* case of obviousness of independent Claims 9, 14 and 17, as amended, and all claims dependent upon them, and that they are in condition for allowance. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejections of those claims and an indication of the allowability of same.

CONCLUSION

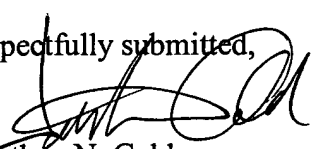
In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5090.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop RCE, COMMISSIONER FOR PATENTS, P. O. Box 1450, Alexandria, VA 22313-1450, on July 19, 2006.


Attorney for Applicant(s)

 7/19/2006
Date of Signature

Respectfully submitted,


Jonathan N. Geld
Attorney for Applicants
Reg. No. 44,702
(512) 439-5090 [Phone]
(512) 439-5099 [Fax]